

## **REMARKS**

### **I. Status of the Claims**

Claims 1, 2, 3, 5, 7-10, 12-14, 16-18, and 20, and new claims 21-28 are the only claims pending in this application. Claims 15 and 19 are canceled by this amendment.

### **II. Rejections For Form**

The Office Action rejects the examined claims 7, 12, 13 and 15 under 35 U.S.C. § 112, second paragraph, for reasons of form listed at paragraph 2 of the Office Action. Applicant respectfully acknowledges the Office Action's review of the claims, and submits that the amendments above overcome each ground of rejection stated by the Office Action.

Claim 7 is amended at line 4 to change the examined recital of "said light course" to "said light source", which has antecedent basis in the claim.

Claim 12 is amended at line 12 to insert "handheld," to provide proper antecedent basis for the recital of "plurality of" at line 15 of the examined claim 12.

Claim 13 is amended at line 13 to change the examined recital of "said generation" to "said emitting," which has proper antecedent basis at line 8 of the claim.

Claim 13 is amended at line 16 to change "team" to "officers," in accordance with the Office Action's suggestion, which has proper antecedent basis at line 3 of the claim.

Claim 15 is canceled.

Applicant respectfully submits, for the reasons presented above, that all of the rejections under 35 U.S.C. § 112, second paragraph, set forth by the Office Action are overcome by the identified amendments to

the claims. Applicant therefore respectfully urges withdrawal of these rejections.

### III. Rejections Based On Prior Art

The Office Action rejects claim 1-3, 5, 7-9, 20 and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,894,625 ("Camras" in view of U.S. Patent No. 5,305,033 ("Takahashi") and U.S. Patent No. 5,073,823 ("Yamada").

Applicant respectfully submits, in response, that the amended base claim 1 is patentable, within the meaning of 35 U.S.C. §§ 102, 103 over the cited art of record, viewing each of the items of prior art singly or viewing their aggregated teachings when viewed in any combination.

The examiners base claim 1 recites, *inter alia*, an apparatus having a handheld light source for emitting a beam of light, including an imager for detecting an image along the axis of the beam of light, with the light source constructed and arranged to emit a beam of light concurrent with imager detecting an image, and having an on/off switch for operating the light source independent from the imager.

The Office Action admits that Camras does not disclose any of the above features. See Office Action at page 4.

The Office Action relies on Takahashi and Yamada as a teaching for modifying Camras to have all of the above-identified claim 1 features. See Office Action at pages 4-5. Stated with greater particularity, the Office Action relies on Takahashi as a teaching of concurrent operation of a light source and an imager, using Takahashi's teaching against such concurrent operation as a teaching for such concurrent operation. *Id.* The Office Action's stated reasoning is that since Takahashi teaches the benefit, namely eliminating picture wash out, by turning the bulb off while

the imager is operating, Takahashi necessarily discloses concurrent operation. *Id.*

Applicant responds that the “washed out picture” disclosed by Takahashi means that the reference can be characterized one of two ways – either it teaches away from claim 1 or it discloses subject matter beyond the broadest reasonable meaning of, and suggesting nothing of, the claim 1 recital of concurrent beam generation and image detecting.

Applicant respectfully submits that, by using Takahashi as a teaching for modifying Camras, the Office Action appears to state that a reference that teaches away from a modification or combination, *e.g.*, shows its ill effects, necessarily discloses or suggests that the modification or combination exists, or is capable being done. Therefore, based on Applicant’s understanding of the Office Action, the Office Action states that regardless of the reference teaching away, it can still used as a suggestion for making the modification. Applicant respectfully submits that such use of a reference in rejecting a claim under 35 U.S.C. § 103(a) is improper.

Applicant, for the foregoing reasons, respectfully submits that the amended base claim 1 is patentable over the cited combination of references.

In addition, to enable Applicant to properly prepare any further submissions in this application, Applicant respectfully further requests the Examiner to please provide authority, *i.e.* case law or a citation to a clear provision of the MPEP, for such use of a reference, *i.e.* Takahashi, that clearly teaches that a structure, function, feature or operation is not desirable, as a teaching for modifying another reference, *i.e.* Camras, to have that structure, function, feature or operation.

Each of method claims 12 and 13 recite the concurrent generation of a light beam and an imager detecting an image on an optical axis along the light beam. The Office Action rejections claims 12 and 13 over the

combination of Camras, Takahashi, Yamada and U.S. Patent No. 4,777,526 ("Saitoh"). Applicant respectfully submits that this combination of references, taken in any combination, in any order, or viewed one at a time, fail to disclose the concurrent generation of a light beam and an imager detecting an image on an optical axis along the light beam.

Applicant respectfully submits that, for this reason standing alone, method claims 12 and 13 are patentable over the cited art of record.

New claim 21 recites:

An security apparatus comprising:

a baton, constructed and arranged for striking a person, having a gripping area and having a structure for supporting a light source and a structure for supporting a video camera;

a switchable light source attached to said structure for supporting a video camera, for switchably emitting a light beam along a beam axis; and

a video camera attached to said structure for supporting a video camera for detecting a video image

The above-recited structure is supported by Applicant's original specification at page 9, lines 19-25, and at FIG. 1, showing the baton shape of the apparatus.

The combination of references cited by the Office Action discloses nothing of combining a video camera with a baton, with or without a light source.

The combination of references cited by the Office Action discloses nothing of concurrent illumination and imaging, where the optical axis of the imager is substantially along the light beam, by any apparatus, much less a security baton.

Applicant respectfully submits that new claim 21 is, for the reasons presented above, patentable over the cited art of record.

Applicant's new claim 25 recites: "In a security baton, an improvement comprising a video camera."

Applicant respectfully submits that none of the cited art of record discloses, teaches or suggests anything of a security baton, much less an improvement comprising a video camera.

Applicant respectfully submits that new claim 25 is, for the reasons presented above, patentable over the cited art of record.

Applicant's new claim 26, dependent on new claim 25, recites:

In the security baton of claim 25, a further improvement comprising a light source for emanating a beam of light substantially collinear with an optical axis of said video camera.

The cited combination of prior art does not teach, disclose or suggest anything of a security baton, much less an improvement comprising a video camera and a light source for emanating a beam of light substantially collinear with an optical axis of the video camera.

Applicant respectfully submits that new dependent claim 26 is, for this additional reason alone, in addition to its being patentable because it depends from a patentable base claim 25, patentable over the cited art of record.

Applicant's new claim 27, dependent on new claim 26, recites:

In the baton of claim 26, a further improvement comprising said light source being capable of emanating said beam of light concurrently with said video camera detecting an image.

Applicant respectfully submits that none of the cited art of record teaches anything of a security baton, much less an improvement comprising a video camera and a light source for emanating a beam light substantially collinear with an optical axis of the video camera, and emanating the beam of light concurrent with the video camera detecting an image.

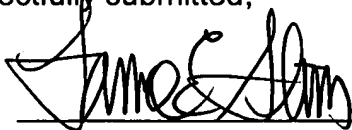
Applicant respectfully submits that new dependent claim 27 is, for this additional reason alone, in addition to its being patentable because it depends from a patentable base claim 25, and a patentable intervening claim 26, patentable over the cited art of record.

#### IV. Conclusion

Applicant respectfully submits, for the reasons presented above, that all pending claims of the present application stand in condition for allowance. Please charge any additional fees that are required to Deposit Account 50-0709. The Examiner is respectfully requested to contact the undersigned, at the telephone number below, if any further action or changes are deemed necessary to expedite this case.

Respectfully submitted,

By



Date:

6/16/2004

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